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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/802,769	03/18/2004	Tohru Harada	250617US2	4671
22850 7590 07/05/2007 OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER MORRISON, JAY A	
			ART UNIT 2168	PAPER NUMBER
			NOTIFICATION DATE 07/05/2007	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com
oblonpat@oblon.com
jgardner@oblon.com

Office Action Summary

Application No.

10/802,769

Applicant(s)

HARADA ET AL.

Examiner

Jay A. Morrison

Art Unit

2168

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 April 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Remarks

1. Claims 1-21 are pending.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Paradinas et al. ('Paradinas' hereinafter) (Publication Number 2002/0116478).

As per claim 1, Paradinas teaches

A file creation method which creates a program-addition file for adding a program to a program-initiation recording medium of an information processing apparatus, comprising the steps of: (see abstract and background)

acquiring identification information of the program-initiation recording medium;
(description when card connected, paragraph [0041])

and creating a program-addition file in response to the identification information so that starting of the program on the information processing apparatus is allowed by the program-addition file with the program stored in the program-initiation recording medium. (description and application stored on the smart card to be executed when smart card connected to device, paragraphs [0039]-[0041])

As per claim 2, Paradinas teaches
the step of transmitting the program-addition file to the information processing apparatus via a network. (paragraph [0024])

As per claim 3, Paradinas teaches
the step of storing the program-addition file in a program-addition recording medium (paragraph [0040])

which is used for the addition of the program to the program-initiation recording medium. (Minton v. Nat 'l Ass'n of Securities Dealers, Inc., 336 F.3d 1373, 1381, 67 USPQ2d 1614, 1620 (Fed. Cir. 2003) "whereby clause in a method claim is not given weight when it simply expresses the intended result of a process step positively recited." Examples of claim language, although not exhaustive, that may raise a question as to the limiting effect of the language in a claim are: (A) "adapted to" or "adapted for" clauses; (B) "wherein" clauses; and (C) "whereby" clauses. Therefore intended use limitations are not required to be taught, see MPEP § 2106 Section II(C), MPEP 2111.04 [R-3])

As per claim 4, Paradinas teaches

in the acquiring step, the identification information is acquired from a predetermined information provider device. (paragraph [0055])

As per claim 5, Paradinas teaches

the program-addition file comprises a program file, an electronic signature of the program file, a configuration file, and an electronic signature of the configuration file, so that starting of the program on the information processing apparatus is allowed by the program-addition file with the program stored in the program-initiation recording medium. (paragraphs [0039]-[0041])

As per claim 6, Paradinas teaches

the creating step comprises: acquiring the program file, the electronic signature of the program file, and the configuration file; (paragraphs [0039]-[0041])

and creating a second electronic signature of the configuration file based on the identification information of the program-initiation recording medium and the acquired configuration file. (paragraphs [0039]-[0041])

As per claim 7, Paradinas teaches

the program file, the electronic signature of the program file, and the configuration file are acquired from a predetermined information provider device.
(paragraph [0055])

As per claims 8-9,

These claims are rejected on grounds corresponding to the arguments given above for rejected claims 1-2 and are similarly rejected.

As per claim 10, Paradinas teaches

a file transmitting unit transmitting the program-addition file to a computer terminal in which the program-addition file is stored in a program-addition recording medium. (paragraphs [0039]-[0041])

As per claim 11,

This claim is rejected on grounds corresponding to the arguments given above for rejected claim 5 and is similarly rejected.

As per claim 12, Paradinas teaches

A computer terminal which stores a program-addition file in a program-addition recording medium, the program-addition file being used to add a program to a program-initiation recording medium of an information processing apparatus, the computer terminal comprising: (see abstract and background)

an information transmitting unit transmitting, to a server, information required to acquire identification information of the program-initiation recording medium; (description when card connected, paragraph [0041])

a file receiving unit receiving, from the server, a program-addition file which is created by the server in response to the identification information so that starting of the program on the information processing apparatus is allowed by the program-addition file with the program stored in the program-initiation recording medium; (description and application stored on the smart card to be executed when smart card connected to device, paragraphs [0039]-[0041])

and a file storing unit storing the received program-addition file into the program-addition recording medium. (communication protocol, paragraph [0049])

As per claim 13, Paradinas teaches

This claim is rejected on grounds corresponding to the arguments given above for rejected claim 5 and is similarly rejected.

As per claim 14,

This claim is rejected on grounds corresponding to the arguments given above for rejected claim 1 and is similarly rejected.

As per claim 15,

This claim is rejected on grounds corresponding to the arguments given above for rejected claim 5 and is similarly rejected.

As per claim 16, Paradinas teaches

An information processing apparatus which adds a program to a program-initiation recording medium by using a program-addition recording medium in which a program-addition file for adding the program to the program-initiation recording medium is stored, the information processing apparatus comprising: (see abstract and background)

a recording-medium detection unit detecting the program-addition recording medium in which the program-addition file is recorded; (communication protocol, paragraph [0049])

and a program addition unit performing an authentication check of the program-addition file read from the program-addition recording medium, and adding the program to the program-initiation recording medium according to a result of the authentication check. (description and application stored on the smart card to be executed when smart card connected to device and authentication, paragraphs [0039]-[0041], [0055])

As per claim 17, Paradinas teaches

when there are two or more program-initiation recording mediums, the program addition unit displays a screen to select one of the program-initiation recording

mediums, and adds the program to the selected program-initiation recording medium.
(paragraph [0025])

As per claim 18, Paradinas teaches

This claim is rejected on grounds corresponding to the arguments given above for rejected claim 5 and is similarly rejected.

As per claim 19, Paradinas teaches

A program addition system comprising: (see abstract and background)
a server which creates a program-addition file for being stored in a program-addition recording medium; (application developed and stored as executable code, paragraphs [0039]-[0040])

and an information processing apparatus which adds a program to a program-initiation recording medium by using the program-addition recording medium,
(application stored on smart card, paragraphs [0039]-[0040])

wherein the server is configured to acquire identification information of the program-initiation recording medium, and to create a program-addition file in response to the identification information, so that starting of the program on the information processing apparatus is allowed by the program-addition file with the program stored in the program-initiation recording medium, (description and application stored on the smart card to be executed when smart card connected to device, paragraphs [0039]-[0041])

wherein the information processing apparatus is configured to detect the program-addition recording medium in which the program-addition file is recorded, (communication protocol, paragraph [0049]) to perform an authentication check of the program-addition file read from the program-addition recording medium, and to add the program to the program-initiation recording medium according to a result of the authentication check. (description and application stored on the smart card to be executed when smart card connected to device and authentication, paragraphs [0039]-[0041], [0055])

As per claim 20, Paradinas teaches

A program addition system comprising: (see abstract and background)

a server which creates a program-addition file for being stored in a program-addition recording medium; (application developed and stored as executable code, paragraphs [0039]-[0040])

and an information processing apparatus which adds a program to a program-initiation recording medium by using the program-addition recording medium, (application stored on smart card, paragraphs [0039]-[0040])

wherein the server is configured to acquire identification information of the program-initiation recording medium, and to create a program-addition file in response to the identification information, so that starting of the program on the information processing apparatus is allowed by the program-addition file with the program stored in the program-initiation recording medium, (description and application stored on the

smart card to be executed when smart card connected to device, paragraphs [0039]-[0041])

wherein the information processing apparatus is configured to receive the program-addition file from the server, (communication protocol, paragraph [0049]) to perform an authentication check of the received program-addition file, and to add the program to the program-initiation recording medium according to a result of the authentication check. (description and application stored on the smart card to be executed when smart card connected to device and authentication, paragraphs [0039]-[0041], [0055])

As per claim 21,

This claim is rejected on grounds corresponding to the arguments given above for rejected claim 5 and is similarly rejected.

Response to Arguments

4. Applicant's arguments filed 4/2/07 have been fully considered but they are not persuasive.

With regards to Applicant's argument that Paradinas does not disclose "identification information of the program-initiated recording medium" nor that "creating a program-addition file in response to the identification information", it is noted that Paradinas discloses the dialog allows the abstract application description to be realized

by enriching it with information regarding the device used (paragraph [0052]). Therefore Paradinas discloses the limitation.

With regards to Applicant's argument that Paradinas does not disclose a program file, an electronic signature of the program file, a configuration file, and an electronic signature of the configuration file, it is noted that Paradinas discloses an application and a description (paragraph [0039]). The signatures are not explicitly disclosed as stand alone files but just signatures, which could be read as disclosed during authentication (paragraph [0045]) or even using the communication protocols (paragraph [0049]). Therefore Paradinas discloses the limitation.

With regards to Applicant's argument that Paradinas does not disclose authentication, it is noted that Paradinas discloses authentication of the parties (paragraph [0045]), where one of the parties is read to include the application on the card. Therefore Paradinas discloses the limitation.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

The prior art made of record, listed on form PTO-892, and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jay A. Morrison whose telephone number is (571) 272-7112. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tim Vo can be reached on (571) 272-3642. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



TIM VO
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100

Jay Morrison
TC2100

Tim Vo
TC2100